

REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 3, 8, 10, 17-18, and 33 have been amended, claim 34 has been cancelled without prejudice, and new claims 35-41 have been added. Support for any claim amendments and new claims is found in the specification, claims, and drawings as originally filed, and no new matter has been added. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

Rejections

Rejection Under 35USC §102

Claims 1-33 have been rejected under 35 USC §102(e), as being anticipated by U.S. patent 7,016,062 to Ishizuka ("Ishizuka"). Applicants respectfully traverse the rejection and request reconsideration based on the amendment to claims 3, 8, 10, 17-18, and 33 and features in the claims which are neither disclosed nor suggested in the cited reference.

As to a rejection under §102, "[a]nticipation is established only when a single prior art reference discloses expressly or under the principles of inherence, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc., (1984, CAFC) 221 U.S.P.Q. 385*. The standard for lack of novelty, that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp., 514 F.2d 901,*

185 U.S.P.Q. 723 (9th Cir. 1975); and Cool-Fin Elecs. Corp. v. International Elec. Research Corp., 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

As a preliminary matter generally applicable to the rejections discussed herein, the rejection does not clearly specify which features of the Ishizuka reference allegedly correspond to features recited in the claims. While a portion of the reference is cited by the Office for each of the method steps and code segments, in many cases it is not evident from the cited portion of the reference which elements or features of the reference the Office believes correspond to those recited in the claims, and no supporting explanation is provided in the Office Action.

In particular, the rejection does not specify which features of the Ishizuka reference allegedly correspond to, for example, the archive file, the print request, the file request, the referenced content, the referenced content file, the referenced image, and the data stream. It is believed that these features are not disclosed in the cited reference in as complete detail as is contained in the claims and arranged as required by the claims, and thus Applicants respond on this basis below. However, absent a clear articulation of the corresponding features in the Office Action, the basis for rejecting the claims is uncertain, and the ability of Applicants to respond in a manner that advances the case to issue without undue delay is impeded.

37 CFR §1.104(c)(2) requires that the features in the references that allegedly correspond to the limitations of the claims be pointed out with specificity. This section states:

“[T]he examiner must cite the best references at his or her command. When a reference is complex or shows or describes other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”

Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 CFR §1.104(c)(2) in a non-

final Action if any of the claims are not found to be allowable.

The rejection of independent claim 1, and its dependent claims 2-8, 26, and 32, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 1 recites:

“1. (Previously presented) A method of printing using a mobile device, comprising: accessing remote content including a document; generating on the mobile device an archive file containing the document; transmitting a print request to an imaging device; receiving a file request from the imaging device for the archive file; and transmitting the archive file to the imaging device, whereby the imaging device prints the content.” (emphasis added)

The Ishizuka reference discloses a “method for printing from a wireless mobile device over a computer network including transmitting to a wide area network (WAN) information a user wishes to print using a wireless mobile device. The transmitted information is received by the WAN and forwarded via the WAN to a printer selected by the user. The printer prints the forwarded information” (Abstract).

The Office states that the limitations of the steps of transmitting the print request to an imaging device, receiving a file request from the imaging device for the archive file, and transmitting the archive file to the imaging device are disclosed at various portions of the Ishizuka reference, including col. 8, line 48 – col. 9, line 22. Applicants disagree.

Col. 8, line 48 – col. 9, line 22 describes Figs. 6-7. With regard to transferring the information for printing, blocks 603 and 607 of Fig. 6 continue at block 501 of Fig. 5.

The flowchart of Fig. 5 describes the process for printing over the network. “In step 501, a user transmits information to be printed from a wireless mobile device over a wireless connection. The information to be printed is generated by browsing the Internet, shopping on the Internet, using email, or any other application software” (col. 8, lines 10-14; emphasis added). Then, “a wide area network receives the information to be printed which was transmitted over

the wireless connection" and "the wide area network forwards the information to be printed over the wide area network to the printer 110" (col. 8, lines 19-21 and 30-32).

Thus, the Ishizuka reference teaches that the mobile device transmits the print data, not a print request that is separate from the data. In claim 1, the print request is a different element from the archive file that contains the document which is to be printed. As further recited in claim 1, the imaging device receives a file request from the imaging device for the archive file, and transmits the archive file to the imaging device. There is no disclosure in the Ishizuka reference that the mobile device (i.e. wireless mobile device 106, Fig. 1), receives a file request from the imaging device (i.e. printer 110, Fig. 1) for the print content.

The novel features of the present invention are not anticipated by the Ishizuka reference in that the essential elements of the transmitting, receiving, and transmitting steps, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection is improper at least for that reason and should be withdrawn.

Independent claim 23 recites limitations similar to those of claim 1, discussed above. For similar reasons as explained heretofore with regard to claim 1, the novel features of the present invention are not anticipated by the Ishizuka reference in that at least one essential element, arranged as required by the claim and in as complete detail as in the claim, is absent from the reference. Therefore, the rejection of independent claim 23, and its dependent claim 29, is improper at least for this reason and should be withdrawn.

The rejection of independent claim 9, and its dependent claims 10-15, 27, and 33, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 9 recites:

"9. (Previously presented) A method of printing using a mobile device, comprising:
accessing remote content including a document;

generating on a proxy server an archive file containing the document;
transmitting a print request to an imaging device, the print request including a reference
that indicates a location of the archive file on the proxy server;
receiving a file request at the proxy server from the imaging device for the archive file;
and
transmitting the archive file from the proxy server to the imaging device, whereby the
imaging device prints the content.” (emphasis added)

The limitations recited in the transmitting, receiving, and transmitting steps are similar to those recited in claim 1 in that a request is received for the archive file and the archive file is then transmitted to the imaging device. For similar reasons as explained heretofore with regard to claim 1, there is no disclosure in the Ishizuka reference of any device receiving a file request from the imaging device (i.e. printer 110, Fig. 1) for the print content and transmitting the archive file in response.

Furthermore, claim 9 recites that the archive file resides on a proxy server instead of on the mobile device, instead of the mobile device, and thus the steps of receiving the file request and transmitting the archive file recite the proxy server. The Ishizuka reference does disclose a proxy server 112 (Fig. 1): “The proxy server 112 processes and reformats content provided by Internet Web servers in order that the content provided by the server can be displayed on the display of the wireless device 106” (col. 3, lines 15-18). However, there is no disclosure that the proxy server receives a file request from the imaging device, or transmits the archive file to the
imaging device.

The novel features of the present invention are not anticipated by the Ishizuka reference in that the essential elements of the transmitting, receiving, and transmitting steps, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Independent claim 24 recites limitations similar to those of claim 9, discussed above. For similar reasons as explained heretofore with regard to claim 9, the novel features of the present

invention are not anticipated by the Ishizuka reference in that at least one essential element, arranged as required by the claim and in as complete detail as in the claim, is absent from the reference. Therefore, the rejection of independent claim 24, and its dependent claim 30, is improper at least for this reason and should be withdrawn.

The rejection of independent claim 16, and its dependent claims 17-22 and 28, is respectfully traversed at least because the single cited reference does not disclose all of the essential elements of the claims arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 16 recites:

“16. (Previously presented) A method of printing using a mobile device, comprising: accessing remote content including a document; generating on a proxy server an archive file containing the document; transmitting a print request to an imaging device; receiving a file request from the imaging device for the archive file; transmitting the file request to the proxy server; receiving the archive file from the proxy server in a data stream; and streaming the data stream of the archive file from the mobile device to the imaging device, whereby the imaging device prints the content.” (emphasis added)

The limitation recited in the steps of transmitting a print request, and receiving a file request, are similar to those recited in claim 1. For similar reasons as explained heretofore with regard to claim 1, there is no disclosure in the Ishizuka reference of any device receiving a file request from the imaging device (i.e. printer 110, Fig. 1) for the print content and transmitting the archive file in response.

In addition, the limitations recited in the steps of transmitting the file request to the proxy server, receiving the archive file from the proxy server in a data stream, and streaming the data stream of the archive file from the mobile device to the imaging device are not disclosed in the cited reference. With regard to a data stream, the Ishizuka reference discloses only that “the communication interface 219 sends and receives electrical, electromagnetic or optical signals that carry digital data streams representing various types of information” (col. 5, lines 32-35), that

“[t]he LAN 223 and the Internet 102 both use electrical, electromagnetic or optical signals that carry digital data streams” (col. 5, lines 43-45), and that, in a wireless link, “the communication interface 409 sends and receives electrical, electromagnetic or optical signals that carry digital data streams representing various types of information” (col. 7, lines 14-18). Nowhere does the reference disclose the specific interrelationship of the data stream of the archive file among the proxy server, mobile device, and imaging device that is recited in the steps of claim 16 in order to accomplish printing of the content.

The novel features of the present invention are not anticipated by the Ishizuka reference in that the essential elements of these steps, arranged as required by the claims and recited in as complete detail as in the claim, are absent from the reference. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Independent claim 25 recites limitations similar to those of claim 16, discussed above. For similar reasons as explained heretofore with regard to claim 16, the novel features of the present invention are not anticipated by the Ishizuka reference in that at least one essential element, arranged as required by the claim and in as complete detail as in the claim, is absent from the reference. Therefore, the rejection of independent claim 25, and its dependent claim 31, is improper at least for this reason and should be withdrawn.

Dependent claim 3 is further patentably distinguishable over the cited reference because claim 3 emphasizes additional essential elements that are absent from the single cited reference as arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 3 recites:

“3. (Currently amended) The method of claim 1, wherein the document comprises a web page that contains a link to referenced content, and wherein the step of generating an archive file comprises forming a modified web page in which the link is rewritten to refer to a referenced content file in the archive file instead of to the referenced content.” (emphasis added)

Thus claim 3 recites that a modified web page is generated. The modified web page has a link to referenced content. The link is rewritten to refer to a referenced content file in the archive file instead of to the referenced content.

With regard to claim 3, the Office refers to col. 3, lines 9-52, and col. 7, lines 35-61 (Office Action, p.3). In column 3, the Ishizuka reference discloses that

“The proxy server 112 processes and reformats content provided by Internet Web servers in order that the content provided by the server can be displayed on the display of the wireless device 106. In order to accomplish this task, the proxy server 112 first contacts the Internet Web server that hosts the page the user wishes to visit. The target page is then downloaded to the proxy server 112. The proxy server 112 then strips out the hypertext markup language (HTML) coding and changes it into special format that most wireless mobile devices can read. The proxy server 112 changes the graphics into a format that can be read by many wireless mobile devices as well. After the content has been processed and reformatted by the proxy server 112, the content is sent to the wireless mobile device 106 via the ISP 108” (col. 3, lines 15-29).

If the Office considers the modified web page of claim 3 to be the special format data of the Ishizuka reference, there is no teaching that the special format data is a web page; to the contrary, the HTML is stripped out by the proxy server so the data cannot be a web page. In addition, there is no teaching that the special format data contains a link to referenced content, because HTML code such as anchor tags and img tags have been stripped out since it is stated that HTML could not be processed by most wireless mobile devices. Furthermore, there is no teaching that the special format data is structured as an archive file that includes a referenced content file in addition to the code for the modified web page. Instead, the reference discloses only a functionality requirement that the special format data can be read by most wireless devices.

In column 7, the Ishizuka reference discloses that

“the wireless mobile device 106 converts the information to be printed into a PDF file using Adobe Acrobat software stored in memory unit 307 and then transmits the PDF file to the print server 413. According to an alternative embodiment, the processing of the PDF file can be accomplished in the processor 405 of the printer 110” (col. 7, lines 35-41).

If the Office considers the document of claim 3 to be the PDF file of the Ishizuka

reference, a PDF file is not a web page as recited in claim 3. In addition, the archive file would not be a PDF file because there would be no need to generate a PDF file from an HTML file; the Ishizuka reference acknowledges that HTML files are “universally recognized” by printers (col. 7, lines 27-30) and so the generation of such a file would be unnecessary. Further, there is no disclosure in the cited reference that a PDF file is an archive file containing a referenced content file to which links in the original HTML web page are rewritten.

Thus, in addition to the reasons discussed with regard to claim 1, the novel features of the present invention are further not anticipated by the Ishizuka reference in that the essential elements recited in claim 3, arranged as required by the claim and recited in as complete detail as in the claim, are absent from the cited reference. Therefore, the rejection is improper at least for this additional reason and should be withdrawn.

Dependent claims 10 and 17 recite limitations similar to those of claim 3, discussed above. For similar reasons as explained heretofore with regard to claim 3, therefore, the novel features of the present invention are further not anticipated by the Ishizuka reference in that at least one additional essential element, arranged as required by the claim and in as complete detail as in the claim, is absent from the reference. Therefore, the rejection of dependent claims 10 and 17 is also improper at least for this additional reason and should be withdrawn.

Dependent claim 8 is further patentably distinguishable over the cited reference because claim 8 emphasizes additional essential elements that are absent from the single cited reference as arranged as required by the claims and in as complete detail as in the claims. In this regard, claim 8 recites:

“8. (Currently amended) The method of claim 1, wherein the remote content is located behind a firewall on a secure server that is not accessible by the imaging device, and the step of accessing the remote content comprises transmitting security information from the mobile device to the secure server.” (emphasis added)

In the rejection of claim 8, the Office refers to col. 4, line 42 – col. 6, line 37 (Office

Action, p.4). With regard to servers, the Ishizuka reference discloses that

“The server 104 stores a plurality of printer drivers including UNIX, MAC, and Windows drivers. According to an embodiment of the invention, a generic printer driver specifically configured to enable the wireless mobile device 106 to print using the printer 110 is stored in the memory of the server 104. The server 104 also stores network addresses of printers accessible to the user. Associated with each stored address is the printer driver necessary to operate that printer.

According to an alternate embodiment of the invention, the printer addresses and the associated printer drivers are stored on alternate servers. This configuration enables distributed processing and memory if desired. Moreover, alternate servers enable the printer addresses and the associated printer drivers to be stored on servers protected by firewalls and accessible via the LAN 223.” (col. 4, lines 33-48; emphasis added)

Thus the reference teaches that printer drivers may be located behind a firewall on a server. However, there is no teaching in the reference that the remote content is stored behind the firewall, as recited in claim 8. Nor does the reference teach that the mobile device transmits security information to the server in order to access the content.

Thus, in addition to the reasons discussed with regard to claim 1, the novel features of the present invention are further not anticipated by the Ishizuka reference in that the essential elements recited in claim 8, arranged as required by the claim and recited in as complete detail as in the claim, are absent from the cited reference. Therefore, the rejection is improper at least for this additional reason and should be withdrawn.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case

to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



Robert C. Sismilich
Reg. No. 41,314
Attorney for Applicant(s)
Telephone: (858) 547-9803

Date: 12/1/06

Hewlett-Packard Company
Intellectual Property Administration
P. O. Box 272400
Fort Collins, CO 80527-2400